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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,213	08/17/2001	William Webb	PALM.0863	5012
30554 7590 11/16/2007 SHEMWELL MAHAMED I LLP 4880 STEVENS CREEK BOULEVARD SUITE 201 SAN JOSE, CA 95129			EXAMINER CHANG, KENT WU	
			ART UNIT 2629	PAPER NUMBER
			MAIL DATE 11/16/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 09/932,213	Applicant(s) WEBB ET AL.	
	Examiner Kent Chang	Art Unit 2629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,6-40 and 45-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-40 and 45-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/07 has been entered.

### ***Information Disclosure Statement***

2. The references listed in the Information Disclosure Statement submitted 10/31/07 have been considered by the examiner (see attached PTO-1449).

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 2629

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1, 2, 6-40, 45-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boesen (US Patent No. 5,542,721) in view of Lee (US Patent No. 6,243,595).

Boesen discloses a mobile device having a first segment; a second segment with a first input feature (keypad section 22) moveably coupled to the first segment to move between a contracted position having a reduced length (as shown in Fig.9) and an extended position having a maximum length (as shown in Fig.7) along one axis; a display assembly provided by the first segment, wherein the portion of the display assembly is accessible to contact by a user when the second segment is in the extended position; wherein the second segment overlays the first segment when the second segment is in the contracted position so as to reduce a length of the mobile device as recited in claims 1, 19-21, 27-29, 41; 45-50 (see column 5 lines 23-40 and Figure 7). Obviously, the portion of the first segment being overlaid by the second segment could have varied from none to full length dependent on user's choice, a longer overlaid portion would have lead to a smaller size of the device, while a shorter overlaid portion would have provided more input functions to the user. Furthermore, Boesen includes a pivotable mechanism to allow the user to adjust the angle between the first segment and second segment. However, this function is only for enabling the

Art Unit: 2629

user to use the device in a manner as a phone handset, and the pivoting operation is performed after the sliding operation, wherein the pivotable mechanism is operative independently from the operation of the sliding operation. It would have been obvious for one ordinary skill in the art at the time of the invention to operate the device without the pivoting motion since it merely depends on the user's preference on the angle and length of the device. Boesen teaches a set of input mechanisms (22) in the second segment, but does not expressly teach a multi-directional input mechanism.

However, in the same field of endeavor, Lee teaches a mobile device comprising a first segment having a display, a second segment slidable between a contracted position to cover a portion of the display in the first segment and an extended position, wherein the second segment further comprises a set of input mechanism including a multi-directional input mechanism (elements 8.16-8.19, see figure 3).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to use a multi-directional input mechanism as taught by Lee in the device of Boesen so as to enable easy cursor movement control as well known in the art. It's also well known in the art that such a multi-directional input mechanism can be used to input data for selection of a displayed menu item, a data entry, or an application.

Consider claims 2 and 23. It would have been obvious for one of ordinary skill in the art at the time of the invention to replace the touch screen 38 with a small touch screen and a touch pad so as reduce manufacturing cost of the

device. However, such a modification would have resulted to a touch screen with a small size.

Consider claim 22. The device of Boesen includes character recognition (column 4 lines 53-57).

Consider claims 6-7. Boesen further teaches to provide additional function buttons or other inputs (column 3 lines 51-55). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to modify Boesen's device to include other known input functions such as multi-directional member, touch pad as suggested by Boesen so as to provide the user additional input functions.

The device of Boesen includes a front shell (portion of 4), a midframe (portion of 38), a bottom shell (portion of 24), a first rail and a second rail, a first connecting member and a second connecting member to enable the second segment slide to the first segment (see figures 6 and 7). It would have been obvious for one of ordinary skill in the art at the time of the invention to housing the rails and connecting members in two side surface, the back surface, or other places of the mobile device since the device would function equally well with the rails and connecting members locating in any places (as recited in claims 8-18, 24-26, 30-37, 40). Furthermore, it would have been obvious for one of ordinary skill in the art at the time of the invention to use additional rails (as recited in claim 38-39) in the device of Boesen so as to enable easy moving of the two segments.

**(10) Response to Argument**

Applicant agrees with the examiner in that the device of Boesen (6,542,721) comprises two segments, the first segment (cellular transceiver portion 4 as shown in Figure 7) and the second segment (PDA portion 38), movable between a contracted position and an extended position, but alleges that the only way to achieve the extended position is by pivoting first segment. Applicant relies on Figures 7 and 10 of Boesen for supporting his position.

In response, the examiner indicates that Boesen teaches numerous embodiments to enable the opening and closing of the two segments, as illustrated in Figures 5-15, wherein the structure and operation are completely different in these embodiments. As illustrated in Figure 7, the PDA portion (38) is housed inside of the cellular transceiver portion (4) while in the contracted position, and can be moved out to an extended position **by sliding movement only**, then can be pivoted to allow the user to adjust the angle between the cellular transceiver portion and the PDA portion (note that a portion of the slide hinge 41 is inside of the cellular transceiver portion as shown by the dotted lines in Figure 7). However, the sliding movement can be performed without the pivoting movement if the user is willing to use the phone without adjusting the angle. The pivoting

movement is independent of the sliding movement and can only be performed after the PDA portion has completely moved out to the extended position since **pivoting the hinge or the cellular transceiver portion would be inhibited by the PDA portion before the PDA portion has completely moved out to the extended position.** In fact, the structure and operation of the device of Boesen as shown in Figure 7 are very similar to that of the instant application, wherein the second segment fits inside the first segment so that they slide along one axis without pivoting when moving between the contracted and extended position.

The structure and operation of the device as shown in Fig.7 is completely different from the one shown in Fig. 10 (as shown in Fig. 7, the cellular transceiver portion is thicker than the PDA portion, allowing the PDA portion to house inside the cellular transceiver portion; in Fig. 10, the cellular transceiver portion is thinner than the PDA portion, allowing the PDA portion to house above the cellular transceiver portion). Therefore, appellant's arguments relying on Fig.10 (page 6 of the Brief) are found unpersuasive. In addition, appellant's assertion that the term "slide" is only for modifying "hinge" (see the 4<sup>th</sup> paragraph on page 6 of the Brief) is also found unsupportive and unpersuasive since Fig.7 of Boesen clearly shows a slide hinge having sliding function independent of pivoting function.



As to applicant's arguments with respect to the limitation of the use of a pivotable mechanism, note that Boesen includes a pivotable mechanism to allow the user to adjust the angle between the first segment and second segment. However, this function is **only for enabling the user to use the device in a manner as a phone handset, and the pivoting operation is performed after the sliding operation, wherein the pivotable mechanism is operative independently from the operation of the sliding operation.** It would have been obvious for one ordinary skill in the art at the time of the invention to operate without the pivoting motion since it merely depends on the user's preference on the angle and length of the device.

As to applicant's arguments regarding claims 19, note that Boesen teaches that the second segment moveably coupled to the first segment between a contracted position having a reduced length (or minimum length) and an extended position having a maximum length (as shown in Fig.7) along one axis.

As to applicant's argument regarding to the limitation of having

a set of one or more input mechanisms provided on the second segment, the set of one or more input mechanisms including at least a multi-directional mechanism that is operable to enable the user to enter selection input, including input for selection of displayed data corresponding to any one or more of a menu item, a data entry, or an application;...

note that it would have been obvious to one having ordinary skill in the art at the time of the invention to use a multi-directional input mechanism as taught by Lee in the device of Boesen so as to enable easy cursor movement control as well known in the art. It's also well known in the art that such a multi-directional

Art Unit: 2629

input mechanism can be used to input data for selection of a displayed menu item, a data entry, or an application.

The remainder of the pertinent topics for argument are present in the appropriate rejections above.

### **CONTACT INFORMATION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kent Chang whose telephone number is 571-272-7667. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz, can be reached at 571-272-3638.

**Any response to this action should be mailed to:**

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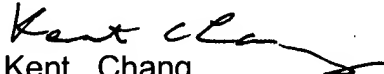
**or faxed to:**

**571-273-8300**

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Art Unit: 2629

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Kent Chang  
Primary Examiner  
Art Unit 2629

kc

11/9/07